

REMARKS

I. Status of the Claims

Applicant respectfully submits this Amendment in response to the final Office Action mailed on September 7, 2011 (the "Office Action"), and the Advisory Action mailed on November 28, 2011. By this Amendment, Applicant has amended claim 1. Claims 1-4, 6, 7, and 9-13 are pending in this application, with claim 1 being independent. No new matter has been added via the claim amendments. For example, Figs. 1-2 and pages 3-4 of the as-filed specification provide support for the amendments.

As an initial matter, Applicant would like to thank Examiner Young for the courtesy of the interview conducted with Applicant's representative on November 22, 2011. In the interview, the Examiner's interpretation of the applied references and the claims was discussed.

The remarks submitted herewith substantially incorporate the substance of the interview. Should the Examiner disagree with Applicant's comments on the substance of the interview, she is invited to contact the undersigned at (202) 408-4335, in order to resolve such disagreement.

In the Office Action, claims 1-4, 6, 7, 9, 11, and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Pub. No. 2004/0089292 to Pollet et al. ("Pollet") in view of U.S. Patent No. 6,003,205 to Dehaven ("Dehaven"); claim 10 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Pollet in view of Dehaven and U.S. Patent No. 6,164,275 to Van Iderstine ("Van Iderstine"); and claims 1 and 13 were rejected under 35 U.S.C. § 103(a)

as allegedly being unpatentable over Pollet in view of U.S. Patent No. 5,564,583 to Kelley et al. ("Kelley").

Applicant respectfully traverses the above rejections for at least the following reasons.

II. Independent Claim 1

Independent claim 1 recites an inhaler comprising, among other things, a body including a mouthpiece, a cap which can be placed in a position to substantially occlude said mouthpiece, wherein said cap is attached to said body by an integrally molded strap, and wherein "said cap, when placed in the position to substantially occlude said mouthpiece, is configured to slide on said strap such that said cap translates away and completely disengages from said mouthpiece by sliding on said strap and prior to the pivoting of said strap."

In rejecting independent claim 1, the Office Action relies on Fig. 5a of Pollet, characterizing tubular body 3 as allegedly corresponding to the claimed body, cap 9 as allegedly corresponding to the claimed cap, and strap 10 as allegedly corresponding to the claimed strap. (See Office Action at 2-3 and 5). The Office Action concedes that "Pollet is silent regarding that when placed in the position to substantially occlude the mouthpiece, the cap can slide on the strap" but relies on alleged teachings of Dehaven and Kelley in an attempt to remedy this deficiency. (Id. at 3 and 5.)

Without necessarily acquiescing to the Office Action's characterizations and assertions, Applicant submits, however, that Pollet fails to disclose, teach, or otherwise suggest a cap attached to a body by an integrally molded strap, wherein "said cap, when placed in the position to substantially occlude [a] mouthpiece, is configured to

slide on said strap such that said cap translates away and completely disengages from said mouthpiece by sliding on said strap and prior to the pivoting of said strap,” nor would one of ordinary skill in the art have been motivated at the time of Applicant’s invention to modify Pollet to include such features.

A. The feature of a cap that “translates away and completely disengages from said mouthpiece by sliding on said strap and prior to the pivoting of said strap” would destroy the principle object and benefits of Pollet.

Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to modify Pollet in an attempt to cure its aforementioned deficiencies.

To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify a reference. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim elements. (See M.P.E.P. § 2143.) Significantly, if the proposed modification would render the prior art being modified unsatisfactory for its intended purpose, then there is no motivation to modify the prior art, and a *prima facie* obviousness rejection cannot be supported. (See M.P.E.P. § 2143.01.)

Pollet discloses an apparatus comprising a tubular body 3 having a lip portion 7 and a cap connected to the body 3 by a strap 10. (See, e.g., Pollet at Figs. 5a-5c.) Pollet further teaches that the strap 10 is “formed of a thermoplastic elastomer material,” (*id.* at ¶ [0040]), and “[a]dvantageously, the inherent elasticity of the thermoplastic elastomer material allows the strap 10 to stretch and extend in length when the cap 9 is

pulled in a direction away from the tubular body 3.” (Pollet at ¶ [0042].) One of ordinary skill in the art, however, would not have been motivated at the time of Applicant’s invention to modify the cap 9 “to be configured to slide on” the elastic strap 10, “such that said cap translates away and completely disengages from [a] mouthpiece by sliding on said strap and prior to the pivoting of said strap,” since such a modification would destroy the benefits and principle purpose taught in Pollet.

Pollet discloses that the strap 10 is stretched to engage the cap 9 with and disengage the cap 9 from a mouthpiece 6 of the Pollet device. (See, e.g., id. at ¶¶ [0042]; [0047].) The elasticity of the strap 10 provides significant benefits. For example, Pollet teaches that

[i]n the engaged position . . . [,] the strap 10 has elastically recovered to its original, unstretched length, such that the strap 10 is held close to the body 3 and does not extend away from the body 3 in a loop formation. As a result the risk of catching the strap 10 on an object and accidentally dislodging the cap [9] is greatly reduced. Also the overall dimensions of the apparatus in the storage condition are reduced.

(Id. at ¶ [0048].) In other words, the elasticity of the strap 10 provides at least the advantages of preventing accidental dislodgment of the cap 9 and providing a more compact apparatus. Accordingly, modifying the strap 10 and the cap 9 “such that said cap translates away and completely disengages from the mouthpiece by sliding on said strap and prior to the pivoting of said strap” would destroy the principle purpose and purported advantages of the Pollet device. By having the cap 9 “translate[] away and completely disengage[] from” the mouthpiece 6 “by sliding on” the strap 10 would defeat the advantages of the strap being “elastically recovered.” The strap 10 would necessarily be longer to accommodate the cap “completely disengag[ing]” from the

mouthpiece 6 “by sliding on” the strap 10, thus destroying the reduced dimensions of the Pollet device and inhibiting the ability to prevent dislodgment of the cap 9.

As such, even assuming, *arguendo*, that any of Dehaven, Kelley, and Van Iderstine discloses a cap attached to a body by an integrally molded strap, wherein “said cap, when placed in the position to substantially occlude said mouthpiece, is configured to slide on said strap such that said cap translates away and completely disengages from said mouthpiece by sliding on said strap and prior to the pivoting of said strap,” one of ordinary skill in the art would not have been motivated at the time of Applicant’s invention to modify Pollet based on any of the aforementioned references.

For at least these reasons, independent claim 1 is patentable over the cited references, and therefore Applicant respectfully requests allowance of claim 1.

III. The Dependent Claims

Claims 2-4, 6, 7, and 9-13 depend from claim 1 and are patentable at least due to their dependency. As explained above, the cited references, alone or in combination, fail to disclose or suggest the features of claim 1.

IV. Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and/or drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in

the drawings. Rather, Applicant is entitled to have the claims interpreted broadly to the maximum extent permitted by statute, regulation, and applicable case law.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered, placing the pending claims in condition for allowance.

Furthermore, Applicant respectfully points out that the Office Action presented some new arguments as to the application of the cited references against Applicant's claims. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the patentability of the pending claims be disputed.

In view of the foregoing amendments and remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the references cited in this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any additional extensions of time required to enter this Amendment
and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 6, 2012

By /Daniel G. Chung/
Daniel G. Chung
Reg. No. 63,553